

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:

August 25, 2004
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

David J. Fox, D.M.D.

v.

David S. Hornbrook

Opposition No. 91121292 to application Serial No. 75866104
filed on December 7, 1999

Howard C. Miskin of Stoll, Miskin & Badie for David J. Fox,
D.M.D.

Freling E. Baker of Brown Martin Haller & McClain for David S.
Hornbrook.

Before Quinn, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

David S. Hornbrook has filed an application to register
the mark "DENTISTRY FOR THE QUALITY CONSCIOUS" for "dental
services."¹

David J. Fox, D.M.D. has opposed registration on the
ground that, *inter alia*, he "has been using the phrase '*Dentistry
for the Quality Conscious*' in his business since 1986 as ... a

¹ Ser. No. 75866104, filed on December 7, 1999, which alleges a date of
first use anywhere and in commerce of June 1994. The word "DENTISTRY"
is disclaimed.

Opposition No. 91121292

descriptive mark for promotion and marketing of his professional services, the General Practice of Dentistry"; that "[a]s such, his use of this word mark and phrase precedes use by applicant for the [above noted] Service Mark by eight years"; that "[t]he phrase '*Dentistry for the Quality Conscious*' became distinctive of [opposer's] ... services by reason of exclusive and continuous use in commerce for a period exceeding five years before any claim of distinctiveness (or use) was made by the Applicant"; that "[t]he proposed Service Mark has subsequently come into common use by a number of dentists in the United States, and as such has become a generic term for professional services both by dentists in general and specialty practice"; that "[s]uch a generic term ... is incapable of functioning as a registrable ... service mark"; that "[t]he service mark proposed by the Applicant is not inherently distinctive" and "has not become distinctive of the applicant's ... services"; and that "[f]or the above reasons," opposer "has not previously made application ... to register the mark '*Dentistry for the Quality Conscious*', instead using it as a common generic descriptive term for his general dental practice."

As an additional ground for opposition, opposer alleges that "[u]pon formation of the Pennsylvania Corporation 'David J. Fox, D.M.D., P.C.' in June of 1998, a corporation formed in part to engage in the practice of dentistry, ... the distinctive phrase '*Quality Dentistry for Discerning Adults*' was put into use"; that, with respect to "high quality, multidisciplinary, specialty level dental care and general adult dental services

Opposition No. 91121292

provided by a dentist or dentists, with specialty certificates in prosthodontics and/or periodontics," an "[a]pplication was made ... for a service mark on the phrase 'Quality Dentistry for Discerning Adults'" and a registration therefor was granted;² and that "[a]pplicant's mark, as used on or in connection with the specified ... services, so resembles the registered mark 'Quality Dentistry for Discerning Adults' as to be likely to cause confusion, or to deceive."

Applicant, in his answer, has denied the salient allegations of the opposition. In addition, as affirmative defenses, applicant has asserted among other things "the equitable defenses of laches, estoppel and acquiescence," alleging that "[a]pplicant has been using his mark continuously since at least [sic] June of 1994 without objection from Opposer."

The record consists of the pleadings; the file of the involved application; and, as opposer's case-in-chief, his testimony, and the exhibits thereto, together with a timely filed notice of reliance on a certified copy of the registration pleaded in the opposition, which shows that while such registration is subsisting, it is actually owned by David J. Fox (a Pennsylvania corporation) rather than by opposer (an individual) as stated in the timely filed notice of reliance which accompanies such copy. Applicant did not take testimony or

² Reg. No. 2,311,366, issued on January 25, 2000, which sets forth a date of first use anywhere and in commerce of June 19, 1998. The word "Dentistry" is disclaimed.

otherwise submit any evidence. Only opposer filed briefs³ and an oral hearing was not requested.

Inasmuch as there is no evidence to support applicant's asserted affirmative defenses, such defenses will not be given further consideration. The issues to be determined herein, therefore, are whether the mark "DENTISTRY FOR THE QUALITY CONSCIOUS" is a generic designation for "dental services"; whether opposer has priority of use of the mark "QUALITY DENTISTRY FOR DISCERNING ADULTS" for his various dental services; and, if so, whether applicant's mark so resembles opposer's mark as to be likely to cause confusion as to source or sponsorship when such marks are respectively used in connection with the parties' services.

According to the record, opposer is a dentist who, since 1984, specializes in prosthodontics and periodontics. Opposer, while formerly a sole practitioner, has since August 1998 rendered his specialty level dental care and general adult dental services under the mark "QUALITY DENTISTRY FOR DISCERNING ADULTS" through a Pennsylvania corporation named David J. Fox,

³ Besides confirming that applicant did not file a brief, opposer's reply brief merely asserts, notably without citation to any authority, that "[t]he Board should treat the fact that Applicant has failed to respond in any way to Opposer's Trial Brief as Applicant's conceding" the issues herein. However, while it is indeed the better practice for a defendant, if it believes that the plaintiff has failed to sustain its burden of proof in the case, to file a brief indicating the inadequacy of the plaintiff's evidence or otherwise arguing the insufficiency of the ground or grounds on which the proceeding has been brought, there is no requirement that a defendant do so. See Trademark Rule 2.128(a)(3); and TBMP § 801.02(b) (2d ed. rev. 2004) ["The filing of a brief on the case is optional, not mandatory, for a party in the position of defendant"]. Consequently, it cannot be said that applicant has conceded the issues herein by failing to file a brief on the case.

Opposition No. 91121292

which he formed in June 1998 and is the "principal shareholder" thereof. (Dep. at 4-5.) Such corporation is the owner, as noted above, of the pleaded registration of the mark "QUALITY DENTISTRY FOR DISCERNING ADULTS" for "high quality, multidisciplinary, specialty level dental care and general adult dental services provided by a dentist or dentists, with specialty certificates in prosthodontics and/or periodontics."

Opposer finished dental school and received a D.M.D degree in 1980. Thereafter, he received a certificate for his general practice dental residency in 1981; he received a certificate in periodontics in 1983; and he received a certificate in periodontal prosthesis and fixed prosthodontics in 1984. Opposer has practiced dentistry in Jenkinstown, Pennsylvania since August 1998. Prior thereto, he practiced dentistry in Doylestown, Pennsylvania from July 1997 to July 1998 and practiced such in Philadelphia, Pennsylvania from 1982 until July 1997.

Opposer promotes his dental practice through an Internet website and has "also ... done some direct mail as well as some newspaper advertisements." (Id. at 9.) He first used the mark "QUALITY DENTISTRY FOR DISCERNING ADULTS" in connection with his dental services in June 1998. In addition, opposer has used the slogan or phrase "DENTISTRY FOR THE QUALITY CONSCIOUS" in various business and promotional materials to indicate the nature or category of his dental services. Specifically, since August 1986, he has used such designation on patient appointment

cards for his dental practice and, beginning in July 1997, the designation was used on his business cards and letterhead while practicing in Doylestown. Opposer, in December 1990, had new year's cards bearing the designation mailed to his patients and, since 1994, has also used such designation in connection with promotional materials on cosmetic dentistry and on pamphlets describing his dental practice, which he distributes to new and prospective patients. The latter, for example, features such slogan on the front cover in the following manner:

DAVID J. FOX, D.M.D.
Dentistry for the Quality Conscious

(Exhibit 6.) Opposer does not consider the phrase "DENTISTRY FOR THE QUALITY CONSCIOUS" to be a mark for his dental services "[b]ecause this phrase has, over the years, come into common use and it's used by a number of dentists around the United States." (Dep. at 22.)

As examples of third-party use of the slogan "DENTISTRY FOR THE QUALITY CONSCIOUS" in a generic manner, that is, as a designation of dental services of a certain kind or category, opposer has furnished display ads by two different dentists. One such advertisement appeared in the December 2002 issue of Main Line Today and touts a dental practice in King of Prussia, Pennsylvania, while the other ran in the 2002 Milwaukee Yellow Pages and advertises a dental practice in Milwaukee, Wisconsin. Opposer has also submitted an excerpt from a book by William G. Dickerson, D.D.S. entitled The Exceptional Dental Practice (1992), which prominently features on the front cover thereof the

slogan "DENTISTRY FOR THE QUALITY CONSCIOUS." Opposer notes that he has heard the book's author use such phrase while viewing a videotape of one of the author's lectures and observes in particular that:

Dr. Dickerson has been a prominent speaker on dentistry, he's given many continuing education courses all around the United States ... and I think that this [book] is the source of many doctors around the United States learning or first hearing the phrase "Dentistry for the quality conscious."

(Id. at 26.)

As a further example of third-party use in a generic manner of the phrase "DENTISTRY FOR THE QUALITY CONSCIOUS," opposer has submitted a printout of an Internet website for Waterside Dental Group, P.C. in New York, New York which, as indicated below, uses such phrase on the first page thereof in essentially the same way as does opposer in his advertising:

Waterside Dental Group

Dentistry for the Quality Conscious

(Exhibit 15). In addition, opposer has furnished the results of his Internet searches of the slogan "DENTISTRY FOR THE QUALITY CONSCIOUS," which he conducted on December 9 and 10, 2001 using, respectively, the search engines "Yahoo" and "Dogpile." Such searches revealed numerous instances "of dentists and dental practices across the United States that are using the phrase 'Dentistry for the quality conscious' as a phrase to promote their dental practice," including both applicant and opposer.

(Dep. at 33.) A representative sample thereof is set forth below
(emphasis added):

"Joseph J. Vamo **Dentistry for the Quality Conscious**, Edina, 952-925-3555." -- www.mspmag.com/feature.asp?featureid=2110;

"Dr. Joe Vamo, **Dentistry for the Quality Conscious**, named 'Top Dentist' by Mpls St. Paul Magazine." -- www.edinasmiles.com;

"Our dental "Golden Rule" allows us to do **dentistry for the quality conscious**." -- www.tucson-dentist.com/fees.html;

"Dr. Fallon and his entire staff have been specially trained to help create the smile of your dreams. This is aesthetic **dentistry for the quality conscious**." -- www.shoresmiles.com;

"SOUTHWEST COSMETIC DENTAL. EXCEPTIONAL **DENTISTRY FOR THE QUALITY CONSCIOUS**." -- www.swcosmeticdental.com;

"**Dentistry for the Quality Conscious** Donald G. Katz DDS, FAGD 1195 Bustleton Avenue Philadelphia, PA 19116" -- www.drdonkatz.com;

"Museum Dental Center, Exceptional **Dentistry For The Quality Conscious**, General Dentistry, Dental Implants, Cosmetic Dentistry & Laser Dentistry." -- www-hsc.usc.edu/~khalifeh/;

"**Dentistry for the Quality Conscious** To acquaint you with our office, we're offering all new adult patients \$25.00 off your first out-of-pocket expense." -- www.hycomb.com/offer,smile.html;

"Our staff is genuinely interested in each patient. Bloomington Dental is '**Dentistry for the Quality Conscious**.'" -- [www.southernutah.com/exec/index/Business/Companies/Medical and Fitness](http://www.southernutah.com/exec/index/Business/Companies/Medical%20and%20Fitness);

"High Quality, Cutting-edge Dentistry for the Quality Conscious Patient." -- www.dvcnetwork.com/briglia; and

"Jim Rolfe DDS. Responsible **Dentistry for the Quality-Conscious** 963-2329" -- www.independent.com/classifieds/healthysself.html

Finally, while acknowledging that he does not know of any incidents of actual confusion between applicant's use of the phrase "DENTISTRY FOR THE QUALITY CONSCIOUS" in connection with dental services and opposer's use of the mark "QUALITY DENTISTRY FOR DISCERNING ADULTS" for various dental services, opposer testified that he believes that confusion is likely. The reason therefor, opposer maintains, is not only "because of the similarity between the mark[s]," but is also due to the fact that "[w]e get patients as a result of the advertising that we do on the Internet web site." (Id. at 28.) As opposer explained, "[o]n Internet web engines[,] if the words 'quality' and 'dentistry' are simultaneously entered as a search phrase, both marks will appear and have appeared and that's a source of confusion." (Id.)

Turning first to the issue of genericness, opposer argues that the record establishes that applicant "does not have exclusive use of the DENTISTRY FOR THE QUALITY CONSCIOUS mark, as this mark has become generic through use by many dentists located in the United States." We agree with opposer that, as shown by the numerous third-party uses thereof, such phrase is so commonly used in the field of dentistry as a designation for a high level of, or excellence in, dental care services as to be generic, in the sense that the slogan essentially denotes a category or class of dentistry to the general public as well as to members of the dental profession.

As set forth by our principal reviewing court in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), "[a] generic term is the common descriptive name of a class of goods or services." Such case also states the following as the legal test for whether a mark, including one which constitutes a slogan or phrase, is considered to be generic:

Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?

Id. However, a showing of the genericness of a mark requires "clear evidence" thereof. In *re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Moreover, as noted in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999), not only is it the case that "[t]he correct legal test" for genericness of phrases or slogans "is set forth in *Marvin Ginn*," but such test "is to be applied to a ... phrase [or slogan] ... as a whole, for the whole may be greater than the sum of its parts," and the test "requires evidence of 'the genus of goods or services at issue' and the understanding by the [relevant] general public that the mark [or phrase or slogan at issue] refers primarily to 'that genus of goods or services.'"

Applying the above legal test, we must first identify the category of services in issue. In this case, the category or type of services identified in applicant's involved application

is clear: "dental services." Opposer, likewise, plainly renders "dental services." Thus, for purposes of determining whether the phrase or slogan "DENTISTRY FOR THE QUALITY CONSCIOUS" is generic, we find that the category of services under the first step of the test in *Marvin Ginn* is dental services.

Turning, then, to the second prong of the *Marvin Ginn* analysis, the critical inquiry in this case is whether the phrase "DENTISTRY FOR THE QUALITY CONSCIOUS" is understood by the patients and dental professionals, who clearly constitute the relevant public, primarily to refer to dental services. We find, as indicated above, that the evidence clearly shows that such slogan is generic in that it is understood by the relevant public as primarily referring to the category or class of dental services which is characterized by an emphasis on quality, that is, a high level of, or excellence in, the providing of patient dental care. Opposer has provided numerous instances showing that the phrase "DENTISTRY FOR THE QUALITY CONSCIOUS" is used, as a whole, not only by the parties themselves but also by many third parties, in print advertising and through the Internet, as a slogan to promote and designate the type or category of dental services which they offer to patients seeking dental care. Opposer, therefore, has demonstrated that such slogan would be understood by the relevant public as being generic with respect to dental services.

Considering next the remaining ground of priority of use and likelihood of confusion, we note with respect to the issue of priority of use that the record establishes that

opposer, as an individual, first used the mark "QUALITY DENTISTRY FOR DISCERNING ADULTS" for his various dental services in June 1998 and has continued to use such mark, through the professional corporation he organized at such time and is the principal shareholder of, since August 1998. However, as to applicant's use of the asserted mark "DENTISTRY FOR THE QUALITY CONSCIOUS," we observe that because there is no testimony or other proof as to his alleged date of first use anywhere and in commerce of June 1994, the earliest date upon which applicant can rely in this proceeding is the December 7, 1999 filing date of his involved application. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974); Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); and Miss Universe, Inc. v. Drost, 189 USPQ 212, 213 (TTAB 1975). Inasmuch as such date is obviously subsequent to the June 1998 date of first use proven by opposer, opposer has established that he has priority of use herein.

Turning, therefore, to the issue of likelihood of confusion, we find upon consideration of the evidence bearing on the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), which are relevant with respect thereto, that opposer has not satisfied his burden of demonstrating that confusion as to source or sponsorship is likely to occur. In particular, it is pointed out in this regard that, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), the two key

considerations in any likelihood of confusion analysis are the similarity or dissimilarity in the goods and/or services at issue and the similarity or dissimilarity of the respective marks in their entireties.⁴ As to the former, such factor clearly favors opposer since, as identified in the involved application, applicant's "dental services" encompass opposer's specialty level dental care and general adult dental services. We consequently agree with opposer that "[t]here can be no serious dispute that the services at issue are [legally] identical" in significant part.⁵ However, as to the latter factor, and assuming for purposes of this discussion that applicant's mark is at most no more than highly suggestive of his services rather than a generic designation therefor, we disagree with opposer's contention that "[t]he marks at issue here are very similar, and will cause actual confusion for customers, since the terms 'quality' and 'dentistry' appear in both marks."

Specifically, not only has opposer admitted that he is unaware of any incidents of actual confusion which have arisen from the contemporaneous use of the marks at issue, but we find that such marks are sufficiently dissimilar that confusion is not

⁴ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks." 192 USPQ at 29.

⁵ As a necessary corollary thereof, the *du Pont* factor pertaining to the similarity or dissimilarity of established, likely to continue trade channels also favors opposer. Nonetheless, and contrary to two other *du Pont* factors mentioned by opposer in his initial brief, his mark has not been shown to be famous nor has it been demonstrated that the conditions under which and buyers to whom dental services are rendered involve a significant number of "impulse" or emergency

likely to result from their use in connection with the respective services. Opposer nonetheless insists that "if an internet [sic] search is conducted for the words 'quality' and 'dentistry,' both marks will appear, leading the customer to believe that the services associated [therewith] are provided by the same dentist." However, when the highly suggestive marks at issue herein are considered in their entirety, applicant's "DENTISTRY FOR THE QUALITY CONSCIOUS" mark is readily distinguishable from opposer's "QUALITY DENTISTRY FOR DISCERNING ADULTS" mark in sound and appearance. Although, concededly, the respective marks share a vague or generalized similarity in connotation in that each contains the descriptive word "QUALITY" and the generic term "DENTISTRY," such similarity is outweighed by the aural and visual differences in the marks. Overall, the highly suggestive marks at issue herein also engender sufficiently different commercial impressions. Plainly, in applicant's mark, the term "QUALITY" is used in reference to the targeted customers for his "DENTISTRY" practice, that is, those who are "QUALITY CONSCIOUS," while in opposer's mark such term refers to his "DENTISTRY" practice, which is oriented to consumers who are "DISCERNING ADULTS." Given such differences in overall sound, appearance and commercial impression, confusion as to the origin or affiliation of the parties' dental services is not likely to occur.

Consequently, while an Internet search using the words "quality" and "dentistry" retrieves, as the record shows, both

patients who would not be expected to exercise care or deliberation in their selection of providers of dental services.

applicant's website (which like numerous other dental practices located through such a search is advertised under the slogan "DENTISTRY FOR THE QUALITY CONSCIOUS") and opposer's website (which he promotes through the use of the mark "QUALITY DENTISTRY FOR DISCERNING ADULTS"), our principal reviewing court has repeatedly cautioned that "[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal."

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from Witco Chemical Co. v. Whitfield Chemical Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967). Accordingly, for the reasons discussed above, we find that the phrase "DENTISTRY FOR THE QUALITY CONSCIOUS," when used by applicant in connection with dental services, does not so resemble the mark "QUALITY DENTISTRY FOR DISCERNING ADULTS," as used by opposer in connection with various dental services, as to be likely to cause confusion.

Decision: The opposition is dismissed as to the ground of priority of use and likelihood of confusion, but is sustained, and registration to applicant is refused, on the ground of genericness.